

Notice of Allowability

Application No.

10/091,244

Examiner

Kathleen M Kerr

Applicant(s)

GOKHALE ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/6/04.
2. ☒ The allowed claim(s) is/are 19-21 and 23-31.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


Kathleen M Kerr
Primary Examiner
Art Unit: 1652

DETAILED ACTION

Application Status

1. In response to the previous Office action, a non-final rejection (mailed on September 27, 2004), Applicants filed a response and amendment received on December 6, 2004. Said amendment cancelled Claims 1-18 and 22, amended Claim 19, and added new Claims 23-31. Thus, Claims 19-21 and 23-31 are pending in the instant Office action and will be examined herein.

Priority

2. As previously noted, the instant application is granted the benefit of priority for the U.S. Provisional Application Nos. 60/272,985 and 60/272,987 both filed on March 2, 2001. The instant application is also granted the benefit of priority for the U.S. non-Provisional Application No. 09/500,747 filed on February 9, 2000 and its provisional application 60/119,363 filed on February 9, 1999.

Withdrawn - Objections to the Specification

3. Previous objection to the specification because the title is not descriptive is withdrawn by virtue of Applicant's amendment to the title.
4. Previous objection to the specification for lacking updated continuity data in the first paragraph is withdrawn by virtue of Applicant's amendment to said paragraph.

5. Previous objection to the specification for incomplete and/or unclear citations is withdrawn by virtue of Applicant's amendment. Applicant's amendment to the Tsuji *et al.* reference (completing the citation) is supported in the provisional document 60/272,987, which is fully incorporated by reference.

Withdrawn - Objections to the Claims

6. Previous objection to Claims 19-21 for depending from non-elected claims is withdrawn by virtue of Applicant's cancellation and/or amendment of said claims.

7. Previous objection to Claims 19-21 for improper grammar in Claim 1 is withdrawn by virtue of Applicant's cancellation and/or amendment of said claims.

Withdrawn - Claim Rejections - 35 U.S.C. § 112

8. Previous rejection of Claims 19-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for the PKS to be used and the unclear terms "RAL" and "ERL" is withdrawn by virtue of Applicant's amendment which utilizing language previously prosecuting in the parent application, now USPN 5,753,173, as suggested by the Examiner.

9. Previous rejection of Claims 19-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for the abbreviation "PKS" is withdrawn by virtue of Applicant's amendment.

10. Previous rejection of Claims 19-21 are rejected under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicant's amendment which utilizing language

Art Unit: 1652

which limits to products used in the methods previously considered adequately described in the prosecution of the parent application, now USPN 5,753,173.

11. Previous rejection of Claims 19-21 under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicant's amendment which utilizing language which limits to products used in the methods previously considered enabled in the prosecution of the parent application, now USPN 5,753,173.

Withdrawn - Claim Rejections - 35 U.S.C. § 102

12. Previous rejection of Claims 19-21 under 35 U.S.C. § 102(b) as being anticipated by McDaniel *et al.* (see IDS 3/4/02, ref. #110) is withdrawn by virtue of Applicant's amendment requiring the PKS modules be from different PKSs.

EXAMINER'S AMENDMENT

13. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Kate Murashige on February 10, 2005.

Amendments to the Claims

14. The claims have been amended as follows:

- a) Rewrite Claim 25 as follows:

---25. The method of claim 19 wherein said hybrid modular PKS comprises a modular structure selected from the group consisting of:

- a) *ery* modules 1 and 3 through 6 inclusive and tylosin module 2, and wherein said polyketide chain is transferred from *ery* module 1 to *tyl* module 2 and then to *ery* modules 3 through 6 inclusive,
- b) *ery* modules 1 through 5 inclusive and narbomycin module 6, wherein said polyketide chain is transferred from *ery* modules 1 through 5 inclusive to *nar* module 6,
- c) modules 1 and 3 through 6 inclusive of *ery* and modules 2-3 of tylosin, spiramycin or niddamycin, wherein said polyketide chain is transferred from *ery* module 1 to modules 2-3 of tylosin, spiramycin or niddamycin and then to *ery* modules 3 through 6 inclusive,
- d) modules 1 through 3 inclusive of tylosin, spiramycin or niddamycin and modules 3 through 6 inclusive of *ery*, and wherein said polyketide chain is transferred from modules 1 through 3 inclusive of said tylosin, spiramycin or niddamycin to *ery* modules 3 through 6 inclusive,
- e) a module of tylosin, spiramycin or niddamycin and modules 1-2 and 3 through 6 inclusive of *ery*, wherein said polyketide chain is transferred from *ery* modules 1-2 to the tylosin, spiramycin or niddamycin module and then to *ery* modules 3 through 6 inclusive,
- f) modules 1 and 3 through 6 inclusive of *ery* and module 5 of tylosin, spiramycin or niddamycin having the enoyl reductase catalytic activity inactivated, wherein said

Art Unit: 1652

polyketide chain is transferred from *ery* module 1 to module 5 of tylosin, spiramycin or niddamycin and then to *ery* modules 3 through 6 inclusive,

- g) *ery* modules 1 through 4 inclusive and 6 and module 6 of spiramycin or niddamycin, wherein said polyketide chain is transferred from *ery* modules 1 through 4 inclusive to module 6 of spiramycin or niddamycin and then to *ery* module 6,
- h) module 1 of FK-506 or 520 and modules 2 through 14 inclusive of rapamycin, wherein said polyketide chain is transferred from module 1 of FK-506 or 520 and then to modules 2 through 14 inclusive of rapamycin,
- i) module 1 and 11 through 14 inclusive of rapamycin and modules 2 through 6 inclusive of FK-506 or 520 wherein said polyketide chain is transferred from module 1 of rapamycin to modules 2 through 6 inclusive of FK-506 or 520 and then to modules 11 through 14 inclusive of rapamycin,
- j) module 1 of rapamycin, modules 2 through 7 inclusive of FK-506 or 520 and modules 12 through 14 inclusive of rapamycin, wherein said polyketide chain is transferred from module 1 of rapamycin to modules 2 through 7 inclusive of FK-506 or 520 and then to modules 12 through 14 inclusive of rapamycin,
- k) module 1 of rapamycin, modules 2 through 8 inclusive of FK-506 or 520 and modules 13-14 of rapamycin, wherein said polyketide chain is transferred from module 1 of rapamycin to modules 2 through 8 inclusive of FK-506 or 520 and then to modules 13-14 of rapamycin, and

Art Unit: 1652

- l) modules 1 through 10 inclusive of rapamycin and modules 7 through 10 inclusive of FK-506 or 520, wherein said polyketide chain is transferred from modules 1 through 10 inclusive of rapamycin to modules 7 through 10 inclusive of FK-506 or 520.---

- b) Rewrite Claim 31 as follows:

---31. The method of claim 26 wherein said hybrid modular PKS comprises a modular structure selected from the group consisting of:

- a) *ery* modules 1 and 3 through 6 inclusive and tylosin module 2, and wherein said polyketide chain is transferred from *ery* module 1 to *tyl* module 2 and then to *ery* modules 3 through 6 inclusive,
- b) *ery* modules 1 through 5 inclusive and narbomycin module 6, wherein said polyketide chain is transferred from *ery* modules 1 through 5 inclusive to *nar* module 6,
- c) modules 1 and 3 through 6 inclusive of *ery* and modules 2-3 of tylosin, spiramycin or niddamycin, wherein said polyketide chain is transferred from *ery* module 1 to modules 2-3 of tylosin, spiramycin or niddamycin and then to *ery* modules 3 through 6 inclusive,
- d) modules 1 through 3 inclusive of tylosin, spiramycin or niddamycin and modules 3 through 6 inclusive of *ery*, and wherein said polyketide chain is transferred from modules 1 through 3 inclusive of said tylosin, spiramycin or niddamycin to *ery* modules 3 through 6 inclusive,

Art Unit: 1652

- e) a module of tylosin, spiramycin or niddamycin and modules 1-2 and 3 through 6 inclusive of *ery*, wherein said polyketide chain is transferred from *ery* modules 1-2 to the tylosin, spiramycin or niddamycin module and then to *ery* modules 3 through 6 inclusive,
- f) modules 1 and 3 through 6 inclusive of *ery* and module 5 of tylosin, spiramycin or niddamycin having the enoyl reductase catalytic activity inactivated, wherein said polyketide chain is transferred from *ery* module 1 to module 5 of tylosin, spiramycin or niddamycin and then to *ery* modules 3 through 6 inclusive,
- g) *ery* modules 1 through 4 inclusive and 6 and module 6 of spiramycin or niddamycin, wherein said polyketide chain is transferred from *ery* modules 1 through 4 inclusive to module 6 of spiramycin or niddamycin and then to *ery* module 6,
- h) module 1 of FK-506 or 520 and modules 2 through 14 inclusive of rapamycin, wherein said polyketide chain is transferred from module 1 of FK-506 or 520 and then to modules 2 through 14 inclusive of rapamycin,
- i) module 1 and 11 through 14 inclusive of rapamycin and modules 2 through 6 inclusive of FK-506 or 520 wherein said polyketide chain is transferred from module 1 of rapamycin to modules 2 through 6 inclusive of FK-506 or 520 and then to modules 11 through 14 inclusive of rapamycin,
- j) module 1 of rapamycin, modules 2 through 7 inclusive of FK-506 or 520 and modules 12 through 14 inclusive of rapamycin, wherein said polyketide chain is transferred from module 1 of rapamycin to modules 2 through 7 inclusive of FK-506 or 520 and then to modules 12 through 14 inclusive of rapamycin,

- k) module 1 of rapamycin, modules 2 through 8 inclusive of FK-506 or 520 and modules 13-14 of rapamycin, wherein said polyketide chain is transferred from module 1 of rapamycin to modules 2 through 8 inclusive of FK-506 or 520 and then to modules 13-14 of rapamycin, and
- l) modules 1 through 10 inclusive of rapamycin and modules 7 through 10 inclusive of FK-506 or 520, wherein said polyketide chain is transferred from modules 1 through 10 inclusive of rapamycin to modules 7 through 10 inclusive of FK-506 or 520.---


Conclusion

15. Claims 19-21 and 23-31 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (571) 272-0931. The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen M Kerr
Primary Examiner
Art Unit 1652

February 15, 2005